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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 10/602,231 | 06/24/2003 | Tetsujiro Kondo | 450108-4519.2 | 8511 |
| 7590 10/28/2005 FROMMER LAWRENCE & HAUG, LLP. 745 FIFTH AVENUE, 10TH FLOOR NEW YORK, NY 10151 | | | EXAMINER COUSO, JOSE L | |
| | | | ART UNIT 2621 | PAPER NUMBER |
| DATE MAILED: 10/28/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/602,231 | Applicant(s) KONDO, TETSUJIRO | |
| | Examiner Jose L. Couso | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/24/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/254,536.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/24/03, 11/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 10-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,480,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards the same subject matter.

The claims in the present application define the invention differently from the claims in the issued U.S. Patent No. 6,480,630, however they are not patentably distinguishable from the claims in the other copending applications. *In re White et al.*, 160 USPQ 417, *In re Thorington et al.*, 163 USPQ 644.

For example, comparing representative claim 10 of the present application with representative claim 1 of issued U.S. Patent No. 6,480,630. Claim 10 of the present application recites- An integrative encoding system for encoding and transmitting a plurality of video signals having different resolutions, comprising: (Claim 1 of issued

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U.S. Patent No. 6,480,630 recites: An integrative encoding system for encoding and transmitting a plurality of video signals having different resolutions, comprising:); Claim 10 of the present application recites- a compression processor for performing hierarchical encoding on the plurality of video signals by selectively replacing pixels of a higher resolution level with pixels from a lower resolution level calculated by combining pixels from the higher resolution level, thereby encoding a hierarchy of resolution levels within the plurality of video signals without increasing the amount of data (Claim 1 of issued U.S. Patent No. 6,480,630 recites: a compression processor for performing hierarchical encoding on the plurality of video signals by selectively replacing pixels of a higher resolution level with pixels from a lower resolution level calculated by combining pixels from the higher resolution level, thereby encoding a hierarchy of resolution levels within the plurality of video signals without increasing the amount of data); Claim 10 of the present application recites- an editing processor for editing the hierarchically encoded plurality of video signals into a bit stream (Claim 1 of issued U.S. Patent No. 6,480,630 recites: an editing processor for editing the hierarchically encoded plurality of video signals into a bit stream); Claim 10 of the present application recites- an integrated services digital broadcasting (ISDB) transmitter having: (Claim 1 of issued U.S. Patent No. 6,480,630 recites: an integrated services digital broadcasting (ISDB) transmitter having:); Claim 10 of the present application recites- having a time code generator for generating a time code synchronized to the bit stream (Claim 1 of issued U.S. Patent No. 6,480,630 recites: having a time code generator for generating a time code synchronized to the bit stream); Claim 10 of the present application recites- an

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additive information generator for generating additive information in synch with the synchronous signal (Claim 1 of issued U.S. Patent No. 6,480,630 recites: an additive information generator for generating additive information in synch with the synchronous signal); Claim 10 of the present application recites- and a multiplexer for multiplexing the bit stream, the additive information, and the time code into ISDB data for transmission (Claim 1 of issued U.S. Patent No. 6,480,630 recites: and a multiplexer for multiplexing the bit stream, the additive information, and the time code into ISDB data for transmission).

As the comparison shows the difference is merely the additional recitation of "an additional sync block processor for forming a bit stream from the edited and compressed plurality of video signals and a synchronous signal" in issued U.S. Patent No. 6,480,630. All other functions are carried out on the data and/or elements and in no way affects how the data would be received from an input, processed and output within the context of the claims. Therefore, the additional limitation would have been obvious to one of ordinary skill in the art at the time of the claimed invention.

Claim 11 of the present application is word for word the same as claim 2 of issued U.S. Patent No. 6,480,630.

Claim 12 of the present application is word for word the same as claim 3 of issued U.S. Patent No. 6,480,630.

Claim 13 of the present application is word for word the same as claim 4 of issued U.S. Patent No. 6,480,630.

Comparing independent claim 14 of the present application with representative claim 1 of issued U.S. Patent No. 6,480,630. Claim 14 of the present application recites- a video signal editing apparatus (Claim 1 of issued U.S. Patent No. 6,480,630 recites: An integrative encoding system for encoding and transmitting a plurality of video signals having different resolutions, comprising:); Claim 14 of the present application recites- video signal input means for inputting a plurality of video signals (Claim 1 of issued U.S. Patent No. 6,480,630 recites:); Claim 14 of the present application recites- data block forming means for forming a data block from the plurality of video signals (Claim 1 of issued U.S. Patent No. 6,480,630 recites: having a time code generator for generating a time code synchronized to the bit stream, an additive information generator for generating additive information in synch with the synchronous signal and a multiplexer for multiplexing the bit stream, the additive information, and the time code into ISDB data for transmission); Claim 14 of the present application recites- compression means for compressing the plurality of video signals by performing hierarchical encoding on the basis of the data block (Claim 1 of issued U.S. Patent No. 6,480,630 recites: a compression processor for performing hierarchical encoding on the plurality of video signals by selectively replacing pixels of a higher resolution level with pixels from a lower resolution level calculated by combining pixels from the higher resolution level, thereby encoding a hierarchy of resolution levels within the plurality of video signals without increasing the amount of data); Claim 14 of the present application recites- and editing means for editing the compressed plurality of video signals on the basis of the

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data block (Claim 1 of issued U.S. Patent No. 6,480,630 recites: an editing processor for editing the hierarchically encoded plurality of video signals into a bit stream).

As the comparison shows the difference is merely the wording used to describe the respective elements. Both "systems" are carrying out the same processing on the data and/or elements and in no way affects how the data would be received from an input, processed and output within the context of the claims. Therefore, the usage of different terminology would have been obvious to one of ordinary skill in the art at the time of the claimed invention.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Chen (U.S. Patent No. 6,072,831).

With regard to claim 14, Chen describes a video signal editing apparatus which describes video signal input means for inputting a plurality of video signals (see figure 4, elements 405 and 410 and refer for example to column 9, lines 30-47); data block forming means for forming a data block from the plurality of video signals (refer for example to column 13, lines 22-29); compression means for compressing the plurality of video signals by performing hierarchical encoding on the basis of the data block (refer for example to column 13, line 63 through column 14, line 33); and editing means for

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editing the compressed plurality of video signals on the basis of the data block (refer for example to column 10, lines 18-44 and to column 14, lines 42-46).

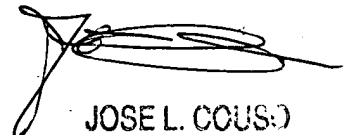
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (571) 272-7388. The examiner can normally be reached on Monday through Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso, can be reached on (703) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the USPTO contact Center whose telephone number is (703) 308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jlc
October 15, 2005



JOSE L. COUSO
PRIMARY EXAMINER